

1 WILLIAM L. ANTHONY, JR. (State Bar No. 166026)
wanthony@orrick.com
2 MATTHEW H. POPPE (State Bar No. 177854)
mpoppe@orrick.com
3 ZHENG LIU (State Bar No. 229311)
jenliu@orrick.com
4 ORRICK, HERRINGTON & SUTCLIFFE LLP
1000 Marsh Road
5 Menlo Park, California 94025
Telephone: +1-650-614-7400
6 Facsimile: +1-650-614-7401

7 Attorneys for Defendant
8 VARIAN MEDICAL SYSTEMS, INC.

9 UNITED STATES DISTRICT COURT
10 NORTHERN DISTRICT OF CALIFORNIA
11 SAN FRANCISCO DIVISION

12 UNIVERSITY OF PITTSBURGH OF THE
13 COMMONWEALTH SYSTEM OF HIGHER
14 EDUCATION d/b/a UNIVERSITY OF
15 PITTSBURGH, a Pennsylvania non-profit
corporation (educational),

16 Plaintiff,

17 v.

18 VARIAN MEDICAL SYSTEMS, INC., a
Delaware corporation,

19 Defendant.
20
21
22
23
24
25
26
27
28

Case No. CV 08-02973 MMC

**VARIAN'S NOTICE OF MOTION
AND MOTION TO TRANSFER
ACTION TO U.S. DISTRICT COURT
FOR WESTERN DISTRICT OF
PENNSYLVANIA; MEMORANDUM
OF POINTS AND AUTHORITIES IN
SUPPORT THEREOF**

[28 U.S.C. § 1404(a)]

Date: August 1, 2008
Time: 9:00 a.m.
Courtroom: 7, 19th Floor

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. STATEMENT OF FACTS	3
A. This Case Is a Duplicate of a Prior Case in the Pennsylvania Court	3
B. The Pennsylvania Case Was Heavily Litigated; Thus, the Pennsylvania Court Is Very Familiar With the Parties, the Patents-in-Suit, and the Issues	3
1. Basic Pleadings and Case Schedule	3
2. Miscellaneous Motions	4
3. Claim Construction	5
C. The Pennsylvania Court Dismissed the Prior Action With Prejudice and UPitt Has Appealed.....	6
D. Pennsylvania Is the Location of Many of the Events Giving Rise to the Action; It Is the Residence of the Largest Number of Non-Party Witnesses; and It Is Otherwise a Convenient Venue for This Litigation	7
III. ARGUMENT	9
A. Transferring This Case to the Pennsylvania Court is Appropriate Pursuant to 28 U.S.C. § 1404(a)	9
B. This Action Could Have Been Filed in the Western District of Pennsylvania	10
C. UPitt’s Choice of Forum Is Entitled to Little Weight Here	10
D. Transferring This Case to the Western District of Pennsylvania Is in the “Interest of Justice” Because That Court Has Already Presided Over an Identical Case	11
E. The Other Relevant Factors Also Favor Transfer to the Western District of Pennsylvania	14
IV. CONCLUSION	15

TABLE OF AUTHORITIES

Page

CASES

<i>A.J. Indus., Inc. v. United States Dist. Court,</i> 503 F.2d 384 (9th Cir. 1974).....	10
<i>Ackert v. Ausman,</i> 198 F. Supp. 538 (S.D.N.Y. 1961).....	11
<i>Advanced Semiconductor Materials America, Inc. v. Applied Materials, Inc.,</i> 1993 U.S. Dist. LEXIS 20045, 30 U.S.P.Q. 2d 1553 (D. Ariz. Sept. 15, 1993).....	13
<i>Baird v. California Faculty Ass'n,</i> 2000 WL 516378 (N.D. Cal. Apr. 24, 2000)	11
<i>Hoffman v. Blaski,</i> 363 U.S. 335, 80 S. Ct. 1084, 4 L. Ed. 2d 1254 (1960).....	10
<i>Hyundai Space & Aircraft Co. v. Boeing Co.,</i> 1999 WL 910131 (N.D. Cal. 1999).....	11
<i>Impra Inc. v. Quinton Instruments Co.,</i> 1990 WL 284713, 17 U.S.P.Q.2d 1890 (D. Ariz. 1990).....	13
<i>Jones v. GNC Franchising, Inc.,</i> 211 F.3d 495 (9th Cir. 2000).....	9, 14
<i>Pacific Car & Foundry Co. v. Pence,</i> 403 F.2d 949 (9th Cir. 1968).....	11
<i>Pennzoil Prods. Co. v. Colelli & Assocs., Inc.,</i> 149 F.3d 197 (3d Cir. 1998).....	10
<i>Piper Aircraft v. Reyno,</i> 454 U.S. 235, 102 S. Ct. 252, 70 L. Ed. 2d 419 (1981).....	11
<i>R.E.F. Golf Co. v. Roberts Metals, Inc.,</i> 1992 WL 161041, 24 U.S.P.Q. 2d 1070 (M.D. Fla. 1992)	13
<i>Reiffin v. Microsoft,</i> 104 F. Supp. 2d 48 (D.D.C. 2000)	11, 12
<i>Sykes v. Eckankar,</i> 1998 WL 296368 (N.D. Cal. 1998).....	13
<i>Stewart Org. v. Ricoh Corp.,</i> 487 U.S. 22, 108 S. Ct. 2239, 101 L. Ed. 2d 22 (1988).....	9
<i>VE Holding Corp. v. Johnson Gas Appliance Co.,</i> 917 F.2d 1574 (Fed. Cir. 1990).....	10

TABLE OF AUTHORITIES
(continued)

	Page
<i>Vencor Nursing Ctrs., L.P. v. Shalala</i> , 63 F. Supp. 2d 1, 6 (D.D.C. 1999)	11

FEDERAL STATUTES AND RULES

28 U.S.C. § 1391(c)	10
28 U.S.C. § 1400(b)	10
28 U.S.C. § 1404(a)	1, 2, 9, 14
F.R.C.P. 19	4

NOTICE OF MOTION AND MOTION

TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:

PLEASE TAKE NOTICE that on August 1, 2008 at 9:00 a.m. or as soon thereafter as the matter may be heard, in the courtroom of the Honorable Maxine M. Chesney, United States District Court, 450 Golden Gate Avenue, San Francisco, CA 94102, defendant Varian Medical Systems, Inc. will and hereby does move the Court for an order transferring this action to the United States District Court for the Western District of Pennsylvania pursuant to 28 U.S.C. § 1404(a). This motion is based on this Notice of Motion and Motion, the Memorandum of Points and Authorities below, the accompanying Declaration of Matthew H. Poppe, Sealed Declaration of Matthew H. Poppe, Declaration of William L. Anthony, Request for Judicial Notice, and [Proposed] Order, all pleadings on file in this action, oral argument of counsel, and any other matter that may be submitted at the hearing or thereafter in connection with this motion.

STATEMENT OF RELIEF THE MOVANT SEEKS

Defendant Varian Medical Systems, Inc. seeks an order transferring this action to the United States District Court for the Western District of Pennsylvania pursuant to 28 U.S.C. § 1404(a). A previous action between the same parties, based on the same patents, was recently dismissed with prejudice by that court after more than a year of intense litigation. Accordingly, that court is in the best position to judge whether this case should be dismissed on res judicata or other grounds or, if the case is to proceed, to preside over the case on its merits. Other relevant factors also support this motion to transfer.

MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

The present action represents forum shopping at its worst. It is an exact duplicate of another case recently dismissed with prejudice by the United States District Court for the Western District of Pennsylvania (the "Pennsylvania Court"). Plaintiff University of Pittsburgh ("UPitt"), having been defeated in its home district after a hard-fought year of litigation, now seeks to pursue the exact same patent infringement causes of action in a new court in hopes of achieving a better result. However, UPitt cannot justify fleeing the Pennsylvania Court. A party may not re-

1 file a case in a second court simply because it does not like the result it obtained in the first court.
2 Defendant and moving party Varian Medical Systems, Inc. (“Varian”) will eventually rely on that
3 duplication in support of a motion to dismiss this action based on res judicata and other grounds.
4 In the meantime, principles of judicial efficiency, convenience, and basic fairness dictate that the
5 action be transferred to the Pennsylvania Court pursuant to 28 U.S.C. § 1404(a).

6 The Pennsylvania Court is extremely familiar with the parties, the patents-in-suit, and the
7 issues. It presided over the prior action for more than a year, which included full discovery, a
8 day-long *Markman* hearing (including live expert testimony), summary judgment proceedings,
9 extensive other motion practice, case management conferences, and a settlement conference. At
10 the conclusion of those proceedings, the Pennsylvania Court granted Varian’s summary judgment
11 motion and dismissed the case with prejudice. The Pennsylvania Court is in the best position to
12 determine whether the judgment dismissing the prior case with prejudice bars this duplicative
13 action. Should the Pennsylvania Court decide that this case should proceed, it is best suited to
14 preside over the case because it already learned so much about the issues in connection with the
15 prior action.

16 Other factors also support a transfer to the Pennsylvania Court. Perhaps most important,
17 there are many third party witnesses — including several of the named inventors — who can be
18 subpoenaed to testify in the Pennsylvania Court but not in California. By contrast, only two non-
19 party witnesses who were deposed in the prior action are located in this district. The location of
20 documents is irrelevant, because the parties already exchanged relevant documents in the prior
21 action and UPitt already conducted an extensive review of Varian’s source code (most of which
22 had to be transported from Switzerland). UPitt obviously cannot claim that the Western District
23 of Pennsylvania is inconvenient, given that UPitt is located in that district and chose to sue Varian
24 there last year. Thus, when all factors are taken into account, they heavily favor transferring this
25 action to the Pennsylvania Court.

26 For these reasons, as explained in greater detail below, Varian respectfully requests that
27 this Court issue an order transferring the present action to the United States District Court for the
28 Western District of Pennsylvania for all further proceedings, pursuant to 28 U.S.C. § 1404(a).

II. STATEMENT OF FACTS

A. This Case Is a Duplicate of a Prior Case in the Pennsylvania Court

This is a patent infringement case. UPitt is the only plaintiff and Varian is the only defendant. The only causes of action are for alleged infringement of two patents: U.S. Patent Nos. 5,727,554 and 5,784,431 (the “554 patent” and “431 patent,” respectively). *See* Docket No. 1 (Complaint). UPitt’s counsel has stated to the press that the accused products include Varian’s “widely distributed Trilogy line,” among others. Poppe Decl., Ex. A.¹

It can easily be seen that this action is nothing but a duplicate of the prior action in the Pennsylvania Court. That too was a patent infringement case. UPitt was the only plaintiff and Varian was the only defendant. The only cause of action was for alleged infringement of the ‘554 patent and the ‘431 patent. *See* RJN, Ex. A.² The accused products included Varian’s Trilogy™ systems. *See* Poppe Decl., Ex. B. Other similarities between the two cases include allegations of contributory infringement, inducement of infringement, and willful infringement; the allegation that each case is an “exceptional case”; and requests for a reasonable royalty, increased damages, attorney fees, interest, and costs. *Compare* Docket No. 1 (Complaint), *with* RJN, Ex. A.

B. The Pennsylvania Case Was Heavily Litigated; Thus, the Pennsylvania Court Is Very Familiar With the Parties, the Patents-in-Suit, and the Issues

The Pennsylvania Court gained a significant degree of familiarity with the Pennsylvania case during the 14 months in which it was active. The Pennsylvania Court enforces an aggressive case schedule. As a result, the parties completed fact discovery and claim construction and had many other interactions with the Court during those 14 months.

1. Basic Pleadings and Case Schedule

The Pennsylvania case was initiated with the filing of the Complaint on April 13, 2007. *See* RJN, Ex. A. Varian answered on May 14, 2007, denying the infringement allegations and

¹ “Poppe Decl.” refers to the Declaration of Matthew H. Poppe in Support of Defendant Varian Medical Systems, Inc.’s Motion to Transfer Action to U.S. District Court for Western District of Pennsylvania, filed herewith.

² “RJN” refers to the Request for Judicial Notice in Support of Defendant Varian Medical Systems, Inc.’s Motion to Transfer Action to U.S. District Court for Western District of Pennsylvania, filed herewith.

1 asserting counterclaims for a declaratory judgment of non-infringement and invalidity. *See* RJN,
 2 Ex. B. On May 16, 2007, a Case Management Conference was held before the Honorable Arthur
 3 J. Schwab, with lead trial counsel for each party present. Anthony Decl. ¶ 2.³ A short time later,
 4 Judge Schwab issued a Case Management Order setting an aggressive case schedule, including
 5 close of fact discovery on October 5, 2007 and a claim construction hearing on November 29,
 6 2007. *See* RJN, Ex. C. Those dates held firm, except for certain discrete items of discovery that
 7 Judge Schwab allowed to proceed after the fact discovery deadline. Poppe Decl. ¶ 2. The Case
 8 Management Order also resolved numerous disputes between the parties regarding details about
 9 how the case should be managed. *See* RJN, Ex. C.

10 2. Miscellaneous Motions

11 Over the next several months, **Judge Schwab ruled on 22 contested motions** filed in the
 12 case. Some of the most significant rulings were on the following contested motions:

- 13 1. Varian's motion to compel UPitt to provide further infringement
 14 contentions. *See* RJN, Ex. D.
- 15 2. Varian's motion for summary judgment for lack of standing. *See id.*, Ex. J.
- 16 3. UPitt's motion pursuant to F.R.C.P. 19 to join Carnegie Mellon University
 as a party. *See id.*, Ex. L.
- 17 4. Varian's motion for leave to file an amended answer and counterclaim.
 18 *See id.*, Ex. Q.
- 19 5. Varian's motion for Rule 11 sanctions. *See id.*, Ex. Y, text entry dated
 04/30/2008.
- 20 6. Varian's motion for contempt sanctions. *See id.*, Ex. R.
- 21 7. UPitt's motion for reconsideration of court's finding of contempt. *See id.*⁴
- 22 8. Varian's motion for entry of judgment. *See id.*, Ex. S.
- 23 9. UPitt's motion requesting entry of judgment. *See id.*

24 ³ "Anthony Decl." refers to the Declaration of William L. Anthony in Support of Defendant
 25 Varian Medical Systems, Inc.'s Motion to Transfer Action to U.S. District Court for Western
 District of Pennsylvania, filed herewith.

26 ⁴ Judge Schwab held UPitt in contempt based on events related to a settlement conference held
 27 before Judge Schwab on March 28, 2008. Anthony Decl. ¶ 3. The settlement conference was
 attended by lead trial counsel and in-house legal/business representatives for both parties. *Id.*
 28 UPitt later accepted the judge's offer to purge the contempt by engaging in a mediation with
 Varian before a paid mediator in Pittsburgh. Poppe Decl. ¶ 3; RJN, Ex. Y, Doc. Nos. 305-308.

10. Varian's motion to dismiss counterclaims without prejudice. *See id.*, Ex. T.

Other contested motions decided by Judge Schwab include:

11. A third party's motion to quash a subpoena duces tecum. *See id.*, Ex. E.
12. Varian's motion for leave to exceed ten fact depositions. *See id.*, Ex. Y, text entry dated 09/12/2007.
13. UPitt's motion to compel Varian "to conduct depositions in compliance with court orders" and a related clarification motion. *See id.*, Exs. G, H.
14. Varian's motion to compel UPitt to cooperate in deposition scheduling. *See id.*, Ex. G.
15. UPitt's motion to compel production of witnesses. *See id.*, Ex. Y, text entry dated 10/10/2007.
16. UPitt's motion for clarification regarding the briefing schedule for UPitt's motion to strike Varian's claim construction tutorial. *See id.*, Ex. Y, text entry dated 11/26/2007. The motion to strike itself was referred to a special master.
17. UPitt's motion to identify additional extrinsic evidence in connection with the claim construction proceedings. *See id.*, Ex. K.
18. Varian's motion to compel further production of documents by UPitt and a subpoenaed third party. *See id.*, Ex. Y, text entry dated 01/30/2008.
19. Varian's motion to compel one of the inventors to re-produce his documents in an intelligible manner. *See id.*, Ex. M.
20. Varian's motion to compel additional deposition time from certain witnesses. *See id.*, Ex. N.
21. Varian's motion to compel UPitt to provide further discovery responses and produce documents. *See id.*, Exs. O, P.

In addition to the motions decided by Judge Schwab, a special master ruled on UPitt's motion to strike Varian's claim construction tutorial and provided a Report & Recommendation on Varian's summary judgment motion. *See id.*, Ex. U; Poppe Decl., Ex. C at 3:10-12..

3. Claim Construction

While fact discovery was ongoing in the Pennsylvania case, the parties also engaged in claim construction proceedings. On August 15, 2007, the parties filed a total of three expert reports on claim construction. *See RJN*, Ex. Y, Doc. Nos. 50-57. On the same day, the parties

///

1 filed a Joint Disputed Claim Terms Chart, summarizing the parties' respective claim construction
2 positions, and a Joint Proposal for Claim Construction Hearing. *See id.*, Ex. Y, Doc. Nos. 47-49.

3 Claim construction briefing started two months later. On October 19, 2007, UPitt filed a
4 40-page opening brief and 28 exhibits. *See id.*, Ex. Y, Doc. Nos. 95-100, 102; Poppe Decl. ¶ 4.
5 On November 2, 2007, Varian filed a 55-page opening brief and 20 exhibits. *See* RJN, Ex. Y,
6 Doc. Nos. 107-108; Poppe Decl. ¶ 4. On November 9, 2007, UPitt filed a 16-page reply brief.
7 *See* RJN, Ex. Y, Doc. No. 113; Poppe Decl. ¶ 4. The parties also exchanged tutorials in the form
8 of animated videos and slides containing text and graphics. Poppe Decl. ¶ 4.

9 On November 29, 2007, the parties appeared before the special master for an all-day claim
10 construction hearing. Each side was represented at the hearing by three attorneys, plus in-house
11 counsel. Opening statements and live tutorials were presented. The parties then each put on live
12 expert testimony, including cross-examination. Finally, the special master heard extensive oral
13 argument by counsel. Poppe Decl. ¶ 5 & Ex. C. The special master and his assistant were paid
14 an hourly rate for their time reviewing the parties' papers and attending the hearing. *Id.* ¶ 5. The
15 case was dismissed before a claim construction ruling issued. *Id.*

16 **C. The Pennsylvania Court Dismissed the Prior Action With Prejudice and UPitt**
17 **Has Appealed**

18 In the course of discovery, Varian learned that UPitt was not the sole owner of the patents-
19 in-suit. Accordingly, on November 23, 2007, Varian filed a motion for summary judgment for
20 lack of standing. *See* RJN, Ex. Y, Doc. Nos. 127-130. Judge Schwab referred the motion to the
21 special master for an initial ruling. *See id.*, Ex. Y, text entry dated 11/26/2007. After full
22 briefing, the special master issued a Report & Recommendation finding that Carnegie Mellon
23 University ("CMU") was a co-owner of the patents-in-suit and recommending that (1) Varian's
24 motion for summary judgment be granted but (2) UPitt be permitted to cure the standing issue by
25 amending its complaint to add CMU as a party. *See* RJN, Ex. U.

26 Varian objected to the special master's recommended remedy. *See id.*, Ex. Y, Doc. Nos.
27 256-257. After another full round of briefing, Judge Schwab adopted the special master's Report
28 & Recommendation in part and denied it in part. *See id.*, Ex. J. He adopted the finding that CMU

1 was a co-owner of the patents-in-suit and the recommendation that Varian's summary judgment
 2 motion be granted, but he rejected the recommended remedy and decided instead that the action
 3 would be dismissed with prejudice. *Id.* Judge Schwab found that UPitt's attempt to add CMU as
 4 a party "was untimely and unfair to defendant" *Id.* at 4-5. "Plaintiff obviously knew of
 5 CMU's existence and its residual rights in the patents-in-suit, and chose not to join CMU, at the
 6 inception of this case. Whether plaintiff's very sophisticated patent counsel made this tactical
 7 decision not to join CMU in order to make discovery of CMU as a non-party more difficult for
 8 defendant, or for some other tactical reason, the Court does not know." *Id.*

9 UPitt later asked Judge Schwab to change the dismissal to be without prejudice. *See* RJN,
 10 Ex. V at 4. However, Judge Schwab rejected that request and entered Judgment in Varian's favor
 11 on June 16, 2008. *See id.*, Ex. S. UPitt has filed a notice of appeal. *See id.*, Ex. W.

12 **D. Pennsylvania Is the Location of Many of the Events Giving Rise to the Action;**
 13 **It Is the Residence of the Largest Number of Non-Party Witnesses; and It Is**
 14 **Otherwise a Convenient Venue for This Litigation**

15 UPitt is located in Pittsburgh, at the heart of the Western District of Pennsylvania. *See*
 16 RJN, Ex. A at ¶¶ 1, 4. It filed the prior action against Varian in that District, thus demonstrating
 17 that the Western District of Pennsylvania is a convenient forum for UPitt. Varian did not object
 18 to litigating in that District. Poppe Decl. ¶ 6; RJN, Ex. Y, *passim*.

19 A substantial part of the events giving rise to both actions took place within the Western
 20 District of Pennsylvania. The five inventors were all in Pittsburgh when the alleged inventions
 21 were developed, two at UPitt and three at CMU. Sealed Poppe Decl., Ex. A at 40:11-41:24,
 22 48:15-49:19, 65:11-67:16, 68:21-69:10, 168:4-17; *id.*, Ex. B at 40:11-13, 41:8-25; *id.*, Ex. C at
 23 12:6-8; *id.*, Ex. D at 21:2-23, 86:21-87:3; *id.*, Ex. E at 6:18-7:23, 36:24-37:16, 43:22-46:21, 54:2-
 24 17.⁵ Most of the allegedly inventive activities, as well as related research conducted by the
 25 inventors after the patent applications were filed, took place in Pittsburgh. *See, e.g., id.*, Ex. A at
 26 96:10-99:9, 138:17-143:16; *id.*, Ex. B at 35:14-38:25, 61:15-64:14, 71:5-20, 171:22-172:22,

27 ⁵ "Sealed Poppe Decl." refers to the Sealed Declaration of Matthew H. Poppe in Support of
 28 Defendant Varian Medical Systems, Inc.'s Motion to Transfer Action to U.S. District Court for
 Western District of Pennsylvania, filed herewith.

1 176:22-178:11, 193:8-196:17. The attorney who prosecuted the patent applications was located
 2 in Pittsburgh at that time. *See id.*, Ex. F at 5:23-6:5, 8:1-15, 14:10-15:14, 19:18-20:19, 22:14-
 3 23:5; Poppe Decl., Exs. D, E. Activities related to the ownership and licensing of the patents-in-
 4 suit have taken place in Pittsburgh. *See* Docket No. 1 (Complaint), Exs. 1, 2, 4; Sealed Poppe
 5 Decl., Ex. E at 6:18-7:23, 36:25-37:16, 43:22-46:21, 71:4-77:5, 78:10-79:14, 80:4-81:21, 88:18-
 6 92:4, 93:2-94:4, 189:23-190:17, 191:8-193:15, 194:3-197:20, 200:16-201:20; *id.*, Ex. G at 7:12-
 7 8:3, 11:7-16, 12:9-13:18, 20:22-22:3, 59:8-60:6, 61:14-62:3, 93:10-94:21; *id.*, Ex. R at 5:14-6:1,
 8 22:13-25:7, 48:3-53:10; *id.*, Exs. H-Q, S. Varian even had meetings with UPitt personnel in
 9 Pittsburgh to discuss (1) possible joint research that UPitt claims would have been related to the
 10 patented inventions and (2) sales of accused products by Varian to the University of Pittsburgh
 11 Medical Center. *See* Sealed Poppe Decl., Ex. T at 257:24-258:9, 282:14-289:20, 306:11-307:7.

12 The Western District of Pennsylvania is a much more convenient forum than the Northern
 13 District of California for potential witnesses in this action. During the first action between the
 14 parties, Varian deposed 15 witnesses. Poppe Decl. ¶ 7. Of those, 12 witnesses were deposed in
 15 Pittsburgh. *Id.* Two others were deposed in locations even further eastward. *Id.* Indeed, even
 16 one of Varian's witnesses was deposed in Pittsburgh because he had to fly from Switzerland,
 17 where he lives and works at a Varian facility, and it was easier for him to fly to Pittsburgh than to
 18 California. *See id.*, Ex. F at 3:18-4:6, 20:8-21:2. A second Varian witness also flew to the United
 19 States from Switzerland for a deposition. Poppe Decl. ¶ 7. Two other Varian witnesses deposed
 20 by UPitt reside on the east coast. *Id.* In addition, one of Varian's experts resides in Ann Arbor,
 21 Michigan, and therefore can reach Pittsburgh more easily than California. *Id.*

22 Many witnesses are not affiliated with any party and could only be subpoenaed to testify
 23 at trial in the Western District of Pennsylvania. That is true of six witnesses Varian deposed in
 24 this action, including two inventors. *See* Sealed Poppe Decl., Ex. C at 7:16-25; Ex. D at 21:2-25;
 25 *id.*, Ex. E at 6:6-22; Ex. U at 5:7-7:17; Ex. V at 4:24-5:25; Ex. W at 7:6-9, 12:21-25. It is also
 26 true of two former UPitt licensing employees whom Varian was denied the opportunity to depose
 27 but who Varian might want to call at trial. *See* RJN, Ex. X at 4-5; *id.*, Ex. Y, text entry dated
 28 09/12/2007; Sealed Poppe Decl., Ex. B at 142:3-18; *id.*, Ex. E at 67:23-68:2, 94:5-14; *id.*, Ex. U

1 at 29:2-31:5. By contrast, only two non-parties who were deposed in this action reside in
 2 California. Poppe Decl. ¶ 7.

3 The law firm retained by UPitt as its litigation counsel (Morgan, Lewis & Bockius LLP)
 4 has an office in Pittsburgh, which makes the Western District of Pennsylvania a particularly
 5 convenient forum for them and meant UPitt did not need to retain separate local counsel. *Id.* ¶ 8.
 6 Indeed, the Pittsburgh office of Morgan Lewis served as the site for the *Markman* hearing and at
 7 least two depositions in the prior action. *Id.* Varian retained local counsel in Pittsburgh at the
 8 start of the prior action and they were actively involved in the case, taking several depositions and
 9 appearing at hearings. *Id.* Varian's local counsel maintains copies of produced documents and
 10 deposition transcripts from the prior action in their office. *Id.*

11 **III. ARGUMENT**

12 **A. Transferring This Case to the Pennsylvania Court is Appropriate Pursuant to** 13 **28 U.S.C. § 1404(a)**

14 “For the convenience of parties and witnesses, in the interest of justice, a district court
 15 may transfer any civil action to any other district or division where it might have been brought.”
 16 28 U.S.C. § 1404(a). A district court has discretion “to adjudicate motions for transfer according
 17 to an ‘individualized, case-by-case consideration of convenience and fairness.’” *Jones v. GNC*
 18 *Franchising, Inc.*, 211 F.3d 495, 498 (9th Cir. 2000) (quoting *Stewart Org. v. Ricoh Corp.*, 487
 19 U.S. 22, 29, 108 S.Ct. 2239, 101 L.Ed.2d 22 (1988)). A motion under Section 1404(a) requires
 20 that the Court “weigh multiple factors in its determination whether transfer is appropriate in a
 21 particular case.” *Id.* The plaintiff's choice of forum is but one factor in the analysis; the Court
 22 may also consider such things as: (1) the ease of access to sources of proof; (2) the availability of
 23 compulsory process to compel attendance of unwilling non-party witnesses; (3) “those public-
 24 interest factors of systemic integrity and fairness that . . . come under the heading of ‘the interest
 25 of justice’”; (4) the differences in the costs of litigation in the two forums; (5) the respective
 26 parties' contacts with the forum; and (6) the contacts relating to the plaintiff's cause of action in
 27 the chosen forum. *Id.* at 498-99 & n.21 (quoting *Stewart Org.*, 487 U.S. at 30).

28 ///

As explained below, the relevant factors weigh overwhelmingly in favor of transferring this case to the Western District of Pennsylvania. Most importantly, the Pennsylvania Court just finished presiding over an identical case involving the same parties, the same patents, and the same accused products. That court is familiar with the issues in this case, having ruled on many motions and presided over a *Markman* hearing in the prior duplicative case, and it is therefore in the best position to determine the impact on this case of the Judgment it entered in the prior case in which it dismissed UPitt's infringement claims "with prejudice." *See* RJN, Ex. S. In addition, the Western District of Pennsylvania is the more convenient forum for most witnesses in the case, and is the only forum in which many non-party witnesses can be compelled to testify. To the extent any witnesses would be inconvenienced by the transfer, they are Varian's witnesses and UPitt is not in a position to complain. The other relevant factors also weigh in favor of transfer.

B. This Action Could Have Been Filed in the Western District of Pennsylvania

The proposed transferee district must be one in which the plaintiff could have filed the action initially. *Hoffman v. Blaski*, 363 U.S. 335, 343, 80 S.Ct. 1084, 4 L.Ed.2d 1254 (1960); *A.J. Indus., Inc. v. United States Dist. Court*, 503 F.2d 384, 386-89 (9th Cir. 1974). Obviously that requirement is met here, given that UPitt already filed the identical action against Varian once in the Pennsylvania Court and it was actively litigated there to Judgment. Venue could have been based on the patent venue statute, which provides that "[a]ny civil action for patent infringement may be brought in the judicial district where the defendant resides" 28 U.S.C. § 1400(b). "For purposes of venue under this chapter, a defendant that is a corporation shall be deemed to reside in any judicial district in which it is subject to personal jurisdiction at the time the action is commenced." 28 U.S.C. § 1391(c); *VE Holding Corp. v. Johnson Gas Appliance Co.*, 917 F.2d 1574 (Fed. Cir. 1990) (holding that § 1391(c) defines "reside" for purposes of § 1400(b)). Varian is subject to personal jurisdiction in the Western District of Pennsylvania in a case such as this because it sells accused products to customers located in that district, such as the University of Pittsburgh Medical Center. *See* Sealed Poppe Decl., Ex. U at 34:4-36:2; *id.*, Ex. X; *Pennzoil Prods. Co. v. Colelli & Assocs., Inc.*, 149 F.3d 197, 206-07 (3d Cir. 1998) (exercise of personal jurisdiction in Pennsylvania may be based on defendant's sales in state).

C. UPitt's Choice of Forum Is Entitled to Little Weight Here

Although the plaintiff's choice of forum is usually accorded "substantial deference," "substantially less deference is warranted when the forum preferred by the plaintiff is not his home forum." *Reiffin v. Microsoft*, 104 F. Supp. 2d 48, 52 (D.D.C. 2000) (citing *Piper Aircraft v. Reyno*, 454 U.S. 235, 255-56, 102 S.Ct. 252, 70 L.Ed.2d 419 (1981); *Pacific Car & Foundry Co. v. Pence*, 403 F.2d 949, 954 (9th Cir. 1968); *Hyundai Space & Aircraft Co. v. Boeing Co.*, 1999 WL 910131, 4 (N.D. Cal. 1999); *Ackert v. Ausman*, 198 F. Supp. 538, 542 (S.D.N.Y. 1961)). Here, UPitt has not filed the action in its home forum but rather has specifically avoided its home forum in a blatant forum shopping move after losing an identical case in that court. Accordingly, its choice of forum is entitled to little or no deference.

D. Transferring This Case to the Western District of Pennsylvania Is in the "Interest of Justice" Because That Court Has Already Presided Over an Identical Case

District courts regularly transfer cases to other districts that have already handled related cases. Doing so is in the "interest of justice" because it avoids duplicative proceedings, serves judicial efficiency, and reduces the likelihood of inconsistent judgments.

A case that is very similar to the present case is *Reiffin v. Microsoft Corp.*, 104 F. Supp. 2d 48 (D.D.C. 2000). There, the plaintiff had filed a previous action in the Northern District of California alleging patent infringement by Microsoft. The Northern District found that plaintiff's patents were invalid. In the second case, the plaintiff challenged the prior court's validity ruling and argued that improper litigation conduct by Microsoft, together with other alleged conduct, constituted antitrust violations. *Id.* at 53-55. The D.C. District held that the plaintiff had several avenues available to him to raise those allegations, but "none of them involve filing a largely duplicative action in this district." *Id.* at 55. "The interest-of-justice factor encompasses the desire to avoid multiple litigation from a single transaction [and] to try related litigation together" *Id.* (quoting *Vencor Nursing Ctrs., L.P. v. Shalala*, 63 F. Supp. 2d 1, 6 (D.D.C. 1999)); see also *id.* at 58 n.19 ("The fact that another court has been the site of a related action is so strong a public interest factor that this court has transferred venue *sua sponte.*"); *Baird v. California*

///

1 *Faculty Ass’n*, 2000 WL 516378, *1 (N.D. Cal. Apr. 24, 2000) (“Related litigation pending in the
2 proposed transferee forum is a factor that weighs heavily in favor of transfer”).

3 As in the present case, the plaintiff in *Reiffin* had appealed from the adverse ruling in the
4 first action. The D.C. District found that this factor further supported the motion to transfer.
5 “Should the Federal Circuit vacate the Northern District’s decision and remand to the Northern
6 District, and this court declined to transfer the instant action to that court, [the plaintiff] would
7 have closely related claims pending in two different districts at once.” *Id.* The same is true here.
8 UPitt has appealed to the Federal Circuit from the Judgment against it in the Pennsylvania Court.
9 *See* RJN, Ex. W. If the Federal Circuit reverses and remands for further proceedings, then two
10 identical lawsuits against Varian for infringing the same two patents would be pending in two
11 different courts. The D.C. District added, “[t]his does not imply that it would be sensible or
12 convenient to litigate this complaint here if the Federal Circuit affirms (and so does not remand to
13 the Northern District of California). No matter what the Federal Circuit decides, litigating this
14 matter here would squander judicial resources and run the risk of inconsistent judgments on the
15 validity and infringement of [the plaintiff’s] patents. [The presiding judge in] the Northern
16 District has already expended substantial time and effort to become familiar with the technology
17 underlying the disputed patents, the prosecution of the patents, the record considered by the
18 Patent Office in issuing the patents, and the legal issues related to the patents’ alleged validity and
19 infringement.” *Reiffin*, 104 F. Supp. 2d at 55. All of these observations also apply in the present
20 case due to the Pennsylvania Court’s extensive involvement with the patents-in-suit and other
21 common issues in the prior action. *See supra* at 3-7. The *Reiffin* court cited many other cases in
22 which transfers were granted to districts where related actions were pending, and it observed that
23 “[p]iecemeal litigation in the complex and technical area of patent . . . law is especially
24 undesirable.” *Reiffin*, 104 F. Supp. 2d at 55-56 & n.14.

25 Yet another factor relied on by the *Reiffin* court that applies equally to the present case is
26 that the first court’s “familiarity with the parties’ dispute...renders it better suited to determining,
27 in the first instance, which issues and claims in the instant complaint are precluded by its decision
28 in Mr. Reiffin’s closely-related first action against Microsoft.” *Id.* at 57 (noting that Microsoft

1 had raised a *res judicata* defense). Varian similarly intends to argue that UPitt's claims in this
 2 action are precluded by the Judgment in the Pennsylvania case. UPitt will argue that it should be
 3 allowed to file a new action because the facts that led the Pennsylvania Court to grant Varian's
 4 summary judgment motion have changed.⁶ The Pennsylvania Court is in the best position to
 5 evaluate UPitt's argument, which will necessarily involve interpreting the scope of, and intent
 6 behind, the entry of judgment in the Pennsylvania case. *See also Sykes v. Eckankar*, 1998 WL
 7 296368, *1 (N.D. Cal. 1998) ("Defendants have made a colorable claim that the principles of *res*
 8 *judicata* apply to plaintiff's present action, based on a recently-dismissed case, also filed by
 9 plaintiff, with similar facts. . . . [I]n light of . . . the interests of justice in having defendants' claim
 10 of *res judicata* decided by a judge with knowledge of the previous litigation between the parties,
 11 the court grants defendants' motion to transfer.").

12 In another case, a transfer was granted based on the existence of a related case in another
 13 district even though the similarity between the two cases was not as strong as it is here. *See*
 14 *Advanced Semiconductor Materials America, Inc. v. Applied Materials, Inc.*, 1993 U.S. Dist.
 15 LEXIS 20045, 30 U.S.P.Q.2d 1553 (D. Ariz. Sept. 15, 1993). The court first noted "the general
 16 rule [that] cases should be transferred to districts where related actions are pending." *Id.* at *3
 17 (quoting *Impra Inc. v. Quinton Instruments Co.*, 1990 WL 284713, 17 U.S.P.Q.2d 1890, 1891 (D.
 18 Ariz. 1990)). It then ruled that the defendant's motion to transfer would be granted. "While the
 19 dispute in this case does involve different patents from those at issue in the two cases now
 20 pending between the parties in California, all three lawsuits involve the same parties, the same
 21 technology, and competing products in the same relevant markets." *Id.* at *4. As a result, "there
 22 will likely be much overlap of issues, witnesses, prior art, and documents." *Id.* In addition, the
 23 court in the earlier-filed actions "has greater experience with the parties' dispute." *Id.* at *5.

24 _____
 25 ⁶ Summary judgment was granted in Varian's favor in the Pennsylvania case based on a finding
 26 that UPitt was not the sole owner of the patents-in-suit and thus lacked standing to sue. *See* RJN,
 27 Ex. J. UPitt claims that it is now the sole owner of the patents by virtue of a recent assignment of
 28 rights by the former co-owner, CMU. *See* Docket No. 1 (Complaint) at ¶¶ 10, 15 & Ex. 1. Varian intends to argue that any recent acquisition of additional rights by UPitt is irrelevant; the Pennsylvania Court dismissed the prior action "with prejudice" because UPitt unreasonably failed to join all co-owners as parties in a timely way in the prior action. It cannot have another bite at the apple now.

1 Many other courts have reached the same conclusion. *See, e.g., R.E.F. Golf Co. v. Roberts*
2 *Metals, Inc.*, 1992 WL 161041, 24 USPQ2d 1070 (M.D. Fla. 1992) (granting transfer to District
3 of Ohio, where related litigation was pending).

4 **E. The Other Relevant Factors Also Favor Transfer to the Western District of**
5 **Pennsylvania**

6 The other relevant factors also support Varian's motion to transfer this action to the
7 Western District of Pennsylvania. As noted above, these factors include such things as the
8 convenience of witnesses; the availability of compulsory process to compel attendance of
9 unwilling non-party witnesses; ease of access to sources of proof; the differences in the costs of
10 litigation in the two forums; the respective parties' contacts with the forum; and the contacts
11 relating to the plaintiff's cause of action in the chosen forum. 28 U.S.C. § 1404(a); *Jones v. GNC*
12 *Franchising, Inc.*, 211 F.3d 495, 498-99 & n.21 (9th Cir. 2000).

13 Here, the Western District of Pennsylvania is a more convenient forum than the Northern
14 District of California for most witnesses and for almost all of the witnesses not affiliated with
15 Varian (on whose behalf UPitt has no basis to complain). *See supra* at 7-9. The Western District
16 of Pennsylvania is more convenient even for certain witnesses associated with Varian, because
17 they live in Michigan, on the east coast, or in Europe. *Id.* For a substantial majority of non-party
18 witnesses with relevant information, the Western District of Pennsylvania is the only venue in
19 which compulsory process is available to compel their attendance at trial. *Id.*

20 The parties—especially UPitt, of course—have substantial contacts with the Western
21 District of Pennsylvania, including many contacts relating to UPitt's causes of action against
22 Varian. *See supra* at 7-9. Among other things, the alleged inventions were developed in
23 Pittsburgh, the patents-in-suit were prosecuted from Pittsburgh, licensing activities were
24 conducted from Pittsburgh, and the inventors had meetings with Varian in Pittsburgh related to
25 their research activities. *Id.* Although Varian's headquarters are in this district and it makes
26 and/or assembles some of the accused products here, that fact should not be given much weight
27 given that Varian is the party requesting transfer here. Moreover, Varian also makes and/or
28 assembles certain accused products or components thereof in Europe, as to which the Western

1 District of Pennsylvania is a more convenient forum, and it has made substantial sales of accused
2 products in the Western District of Pennsylvania. *See, e.g., supra* at 7-9; Poppe Decl., Ex. G at
3 16:19-17:6, 21:8-13.

4 Other factors supporting transfer include the fact that UPitt's lead counsel has an office in
5 Pittsburgh; Varian's use of local counsel in the Western District of Pennsylvania in connection
6 with the Pennsylvania case; and the existence of a full set of relevant documents and deposition
7 transcripts in that locale. *See supra* at 9.

8 **IV. CONCLUSION**

9 For the reasons set forth above, Varian respectfully requests that the Court grant its
10 Motion to Transfer Action to U.S. District Court for the Western District of Pennsylvania.

11 Dated: June 27, 2008

12 WILLIAM L. ANTHONY
13 MATTHEW H. POPPE
14 ZHENG LIU
15 ORRICK, HERRINGTON & SUTCLIFFE LLP

16 By: /s/ Matthew H. Poppe
17 Matthew H. Poppe
18 Attorneys for Defendant
19 VARIAN MEDICAL SYSTEMS, INC.
20
21
22
23
24
25
26
27
28

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of VARIAN'S NOTICE OF MOTION AND
MOTION TO TRANSFER ACTION TO U.S. DISTRICT COURT FOR WESTERN DISTRICT
OF PENNSYLVANIA; MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT
THEREOF was served upon the University of Pittsburgh, through its counsel, via:

_____	Hand-Delivery
_____	Facsimile
_____	First Class, US Mail, Postage Prepaid
_____	Certified Mail-Return Receipt Requested
<u> X </u>	ECF Electronic Service
_____	Overnight Delivery

at the following addresses:

Rita E. Tautkus
Morgan Lewis & Bockius, LLP
One Market – Spear Street Tower
San Francisco, CA 94105
rtautkus@morganlewis.com

Dated: June 27, 2008

/s/ Matthew H. Poppe
Matthew H. Poppe

1 WILLIAM L. ANTHONY, JR. (State Bar No. 166026)
wanthony@orrick.com
2 MATTHEW H. POPPE (State Bar No. 177854)
mpoppe@orrick.com
3 ZHENG LIU (State Bar No. 229311)
jenliu@orrick.com
4 ORRICK, HERRINGTON & SUTCLIFFE LLP
1000 Marsh Road
5 Menlo Park, California 94025
Telephone: +1-650-614-7400
6 Facsimile: +1-650-614-7401

7 Attorneys for Defendant
8 VARIAN MEDICAL SYSTEMS, INC.

9 UNITED STATES DISTRICT COURT
10 NORTHERN DISTRICT OF CALIFORNIA
11 SAN FRANCISCO DIVISION

12 UNIVERSITY OF PITTSBURGH OF THE
13 COMMONWEALTH SYSTEM OF HIGHER
14 EDUCATION d/b/a UNIVERSITY OF
PITTSBURGH, a Pennsylvania non-profit
15 corporation (educational),

16 Plaintiff,

17 v.

18 VARIAN MEDICAL SYSTEMS, INC., a
Delaware corporation,

19 Defendant.

Case No. CV 08-02973 MMC

**[PROPOSED] ORDER GRANTING
VARIAN'S MOTION TO TRANSFER
ACTION TO U.S. DISTRICT COURT
FOR WESTERN DISTRICT OF
PENNSYLVANIA**

[28 U.S.C. § 1404(a)]

Date: August 1, 2008
Time: 9:00 a.m.
Courtroom: 7, 19th Floor

1 Having considered Defendant Varian Medical Systems, Inc.'s Motion to Transfer Action
2 to U.S. District Court for Western District of Pennsylvania, together with any opposition or reply
3 papers on file, the pleadings and papers on file, and arguments of counsel:

4 **IT IS HEREBY ORDERED THAT:**

5 1. Defendant's requested transfer would serve the convenience of parties and
6 witnesses and be in the interest of justice, and therefore Defendant's motion to transfer pursuant
7 to 28 U.S.C. § 1404(a) is hereby **GRANTED**.

8 2. This action shall be transferred to the United States District Court for the Western
9 District of Pennsylvania forthwith.

10 **IT IS SO ORDERED.**

11 Dated: _____, 2008

12
13 By: _____
14 UNITED STATES DISTRICT JUDGE
15
16
17
18
19
20
21
22
23
24
25
26
27
28

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of [PROPOSED] ORDER GRANTING
VARIAN'S MOTION TO TRANSFER ACTION TO U.S. DISTRICT COURT FOR WESTERN
DISTRICT OF PENNSYLVANIA was served upon the University of Pittsburgh, through its
counsel, via:

_____	Hand-Delivery
_____	Facsimile
_____	First Class, US Mail, Postage Prepaid
_____	Certified Mail-Return Receipt Requested
<u> X </u>	ECF Electronic Service
_____	Overnight Delivery

at the following addresses:

Rita E. Tautkus
Morgan Lewis & Bockius, LLP
One Market – Spear Street Tower
San Francisco, CA 94105
rtautkus@morganlewis.com

Dated: June 27, 2008

/s/ Matthew H. Poppe
Matthew H. Poppe